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Pending claims 1-2, 5-6, 8-9, 12 and 18 stand rejected under 35 U.S.C. § 102(e) over U.S. Patent Application No. 2001/0046304 (Rast). Applicant respectfully traverses the rejection and respectfully requests reconsideration of the same.

As to claim 1, Rast nowhere teaches a control unit that both receives data from a storage unit and generates a first audio signal therefrom for output to a speaker of a portable device. In this regard, the only data stored in the system of Rast with respect to audio data are stored selection criterion corresponding to triggers of particular sounds in an ambient environment. E.g., Rast, ¶¶17-18. To contend teaching of this subject matter in Rast, the Office Action points to ¶22 of Rast (Final Office Action, p. 4). However, neither this paragraph nor any other part of Rast teaches that data received from a storage unit of a portable device in a control unit of the portable device is used to generate an audio signal for output to a speaker of the portable device. That is, the recited data and first audio signal is something other than a second audio signal that is generated to reduce undesirable noise. Instead all that ¶22 of Rast teaches is that triggering sounds are stored in a record memory of the headphones of Rast. Where does Rast anywhere teach that a control unit of a portable device receives data from a storage unit of the portable device and generates an audio signal for output therefrom? It does not. For at least these reasons, claim 1 and its dependent claims are patentable over Rast.

As to independent claim 8, Rast nowhere teaches combining of two audio signals in a portable device, where an analog audio signal converted from an audio signal stored in a storage unit of a portable device is combined with a second audio signal generated to reduce undesirable sound. As described above, Rast nowhere teaches storage of an audio signal that is then combined with a generated audio signal. Instead, any combining that is done in the headphones of Rast is done between a noise cancellation signal generated in the headphones and an audio signal from another source. Accordingly, claim 8 and its dependent claims are patentable over Rast.

Claims 19-27 and 30-38 stand rejected under 35 U.S.C. §103(a) over U.S. Patent Application No. 2002/0013784 (Swanson) in view of Rast. Applicant respectfully traverses the rejection. As to claim 19, neither reference teaches or suggests a wireless phone that includes a storage medium to store at least one audio file. In this regard, Swanson merely discloses a cellular phone that can communicate data received from a server of a service provider. For

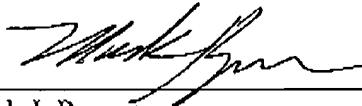
teaching of a storage medium, the Office Action points to portions of Swanson referring to a storage unit at a user's PC or a service provider. Office Action, p. 3. However, such storage units have no bearing on the claimed storage medium of claim 19, which is a storage medium of a wireless phone. With regard to the Office Action's contention that "one of ordinary skill in the art would understand that today a PC is a phone and a phone is a PC" (Office Action p. 5), what one of ordinary skill in the art would understand today is irrelevant to the present application, which was filed in 2001. For this further reason, the rejection of claim 19 and the claims depending therefrom is improper.

The primary reference Swanson merely teaches a cellular telephone. Nowhere however does Swanson (or Rast) teach or suggest a control unit of the cell phone that combines first and second audio signals and provides the combined signal to a speaker of the cell phone. Nor is there any reason to combine Swanson with Rast. In this regard, there is no motivation in either reference to combine their teachings. That is, Rast merely teaches that to download stored selection criteria, a phone may be used. Rast, ¶19. Swanson, on the other hand is merely directed to a cellular phone that can be used in an audio data transmission system that includes cellular phones as receivers of transmissions. Even if combined, the references fail to meet the claimed subject matter.

Thus, as set forth more fully and in Applicant's prior response, there is no motivation to combine these references, and instead the combination is based on improper hindsight-based reconstruction.

In view of these remarks, the application is now in condition for allowance and the Examiner's prompt action in accordance therewith is respectfully requested. The Commissioner is authorized to charge any additional fees or credit any overpayment to Deposit Account No. 20-1504.

Respectfully submitted,



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Mark J. Rozman  
Registration No. 42,117  
TROP, PRUNER & HU, P.C.  
1616 S. Voss Road, Suite 750  
Houston, Texas 77057-2631  
(512) 418-9944 [Phone]  
(713) 468-8883 [Fax]  
Customer No.: 21906